

REMARKS

In an Office Action mailed on February 26, 2010, claims 10, 11, 26, 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hawkins in view of Kilgore; claims 12, 25, 44-48, 50 and 51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hawkins in view of Kilgore and Bijleveld; and claims 27 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hawkins in view of Kilgore, Bijleveld and either Littleton and Ashton.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Applicant respectfully submits that the § 103 rejection of independent claim 10 is deficient for at least the reason that the Office Action fails to identify a plausible reason to explain why the skilled artisan in possession of Hawkins and Kilgore would have derived the claimed invention in view of these references. More specifically, the Examiner concedes that Hawkins fails to disclose resuming a flow to retrieve a tool. Office Action, p. 2. To supply the missing claim limitations, the Examiner relies on Kilgore, a reference that the Board of Appeals has already adjudicated fails to disclose resuming a flow to retrieve a tool. *See, for example*, Decision on Appeal, ll. 23-26, p. 6 and ll. 1-4, p. 7. In the latest Office Action, the Examiner contends that Kilgore is being relied on for the teaching of, "utilizing the pressure of the fluid to retrieve the tool (col. 7, ll. 1-6)." Office Action, p. 2. Applicant respectfully submits, however, that the Examiner is improperly concluding a case of obviousness, without offering any plausible reason to explain why the skilled artisan in possession of Hawkins and Kilgore would have derived the missing limitations of resuming a halted flow to retrieve a tool from a well, absent impermissible hindsight gleaned from the present application.

More specifically, instead of teaching halting a flow to deploy a tool string 315 and then resuming the flow to retrieve a tool string 315, Kilgore discloses a surfacing mechanism to return

the tool string 315 to the wellhead. Kilgore, 6:11-14. Thus, assuming, *arguendo*, a reason exists for returning a deployed ball to the surface, the skilled artisan in possession of Kilgore, would merely glean from Kilgore's disclosure the concept of modifying the ball of Hawkins to impart a hypothetical surfacing mechanism to return the ball to the surface of the well. In other words, at best, the hypothetical modification of Hawkins' ball dropping mechanism in view of Kilgore would produce a system in which flow is not halted and resumed (as neither reference discloses resuming a flow to retrieve a tool), but rather, this hypothetical combination would produce a ball that is deployed in a hypothetical flow and has a surfacing mechanism to return the ball to the surface of the well. Absent the hindsight gleaned from the current application, however, the Examiner has failed to set forth a reason why the skilled artisan would have derived the missing claim limitations of resuming a flow to return the ball to the surface.

Moreover, merely resuming Hawkins' halted flow would not return Hawkins' ball to the surface of the well. In this regard, Hawkins discloses that in the operation of the sub 84 and ball dropping apparatus 64, the fluid is pumped downhole through the tubulars of the well. *See, for example*, Hawkins, 2:31-37. Therefore, the halted flow is a flow into the well, and as such, resuming the flow into the well would tend to force the ball into the well and retain the ball in the seat in which the ball is lodged, as opposed to retrieving the ball from the tubulars. The cited art fails to set forth any type of arrangement to allow the ball to be retrieved from the well by flowing fluid into the well. Even assuming, *arguendo*, that a flow into the well may be used to somehow produce a reverse circulation flow out of the well (which is not taught by the cited references), it is entirely unclear how the ball could be reverse circulated out of the well, especially given the relative size of the ball. Moreover, even assuming, for purposes of argument, that the flow is out of the well, it is entirely unclear that such a flow would even retrieve the ball from the well. In this regard, the Examiner fails to explain why the ball, in the proposed hypothetical combination, would be located in a flow path, which permits the ball to be carried out of the well; and the Examiner fails to explain the mechanism to permit the ball to be placed in such a flow path. Additionally, the Office Action fails to offer any explanation as to why there is even a need or desire to retrieve the ball from the well.

Thus, for at least any of the foregoing reasons, Applicant respectfully requests withdrawal of the § 103 rejection of claim 10.

Applicant respectfully requests withdrawal of the § 103 rejection of claim 44 for similar reasons. In this regard, for at least the reasons that are set forth above, the skilled artisan in possession of Hawkins and Kilgore would not have derived halting the flow of fluid in a well; deploying a tool from within the well while the fluid is halted; and resuming the flow to retrieve the tool. Furthermore, the additional reference relied on by the Examiner, Bijleveld, is directed to a production environment, and there is no apparent reason why the skilled artisan would have or even could have used Hawkins' ball dropping apparatus for purposes of deploying Bijleveld's tool.

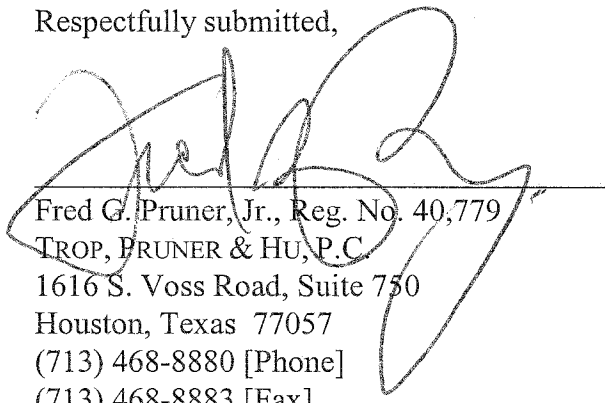
Claims 11, 12, 25-29 and 45-51 and newly-added claims 52 and 53 are patentable for at least the same reasons as the claims from which they depend. Newly-added claims 52 and 53 are patentable for at least the additional, independent reason that these claims recite that the flow is a flow of produced well fluid, which is not taught or rendered obvious by the hypothetical combination of Hawkins and Kilgore.

CONCLUSION

In view of the foregoing, Applicant respectfully requests a favorable action in form of a Notice of Allowance. The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0114US).

Respectfully submitted,

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